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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/774,616

Filing Date: February 10, 2004

Appellant(s): HARRISON ET AL.

Floyd B. Chapman
David J. Kulik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 22, 2005 appealing from the Office action mailed October 20, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The correction is as follows:

An amendment was filed on December 20, 2004 in response to the final office action. In that amendment, Applicant amended claims 1 and 7 and *canceled claims 3-5, 9-11 and 13-17*. An advisory action was mailed to Applicant on December 30, 2004.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 6,309,016 Aloisi. 10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 6-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Aloisi (US 6,309,016).

A) Whether Appellant's claims 1-2, 6-8 and 12 are anticipated under 35 U.S.C. 102(b) by Aloisi?

As to claim 1, Aloisi discloses object holders and organizers comprising arms (52, Fig. 1) or (arms (no numeral), Fig. 4) or (835, Fig. 8) attaches to a body, wherein

the arms form a horizontal position relative to a ground, and wherein the arms together with the body form a holding device and capable of receiving a pair of eyeglasses; a support structure (elements 70, 80, Fig. 1) or (Fig. 4 where the body of figure stands above and holds by elements 430, 450) or (elements 840, 860, Fig. 8) for holding the body of figure in an upright position, wherein the figure is capable of securely holding the pair of eyeglasses.

As to claim 2, Aloisi also teaches the body of figure being fashioned to display a human form.

As to claim 6, Aloisi's body of figure also comprises an element capable of contacting a bridge part of the eyeglasses.

As to claims 7-8 and 12, claims 7-8 and 12 recited most of the limitations similar to those recited in claims 1-2 and 6 therefore also read on Aloisi. Note that claim 7 recited "movable arms wherein the arms can be temporarily fixed in a horizontal position", the examiner interprets the arm as being fixed in a horizontal position but the arm can be movable, therefore in the instant case, the limitation also reads on Aloisi.

In view of the above pointing out based on the teaching of Aloisi, the examiner respectfully submits that all of the limitations of claims 1-2, 6-8 and 12 are fully met by Aloisi and therefore, fully anticipated by Aloisi.

(10) Response to Argument

In the following, the examiner will respond to Appellant's arguments in the Appeal brief that has been either addressed or not addressed in the final action mailed October 20, 2004.

The examiner has carefully reviewed Applicant's arguments in the Appeal Brief of December 22, 2005. These arguments have been fully considered but they are not persuasive.

In the Appeal Brief filed December 22, 2005, Appellant basically contends that (a) it is unreasonable to interpret the content of Aloisi in the way the examiner has to allegedly to anticipate the pending claims; the claims cannot reasonably be interpreted to encompass something as large as the furniture or tables referred to in Aloisi" (page 9, first para), and (b) nothing within the four corners of Aloisi even suggests a figure that can be arranged or sized to accommodate a pair of eyeglasses so that the eyeglass contact each of the arms or appendages as recited in claims 1 and 7.

First, in response to above (a) and (b), the examiner respectfully contends that the phrase "*sized to accommodated a pair of a persons or childs eyeglasses so that the eyeglasses contact each of the arms or appendages*" as recited in claim 1 or 7 is merely a recitation of intended use that is intended to be employed, does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). In the instant case, all the structural

limitations recited in claims 1-2, 6-8 and 12 are clearly met by Aloisi as stated above in the rejection.

Second, the phrase "*sized to accommodate a pair of a person's or child's eyeglasses so that the eyeglasses contact each of the arms or appendages*" is not clear on its face. Size is a relative concept because things may meaningfully be described as "large" or "small", only by relation to other things. In re Burke 22 USPQ 2d 1368, 137 (DCC 1992). It is not all clear simply from reading the elements of claims 1 and 7 at what sizes the inventor would concede to accommodate a pair of a person's eyeglasses so that the eyeglasses contact each of the arms?. In this regard, the examiner further submits that to be valid under 35 USC 112, a patent must not only disclose the invention, it must also do so in a way which is sufficiently definite to put others on notice of the limits of what is claimed. See In re Vamco Mach. And Tool, Inc, 752 F 2d 1564 (224 USPQ 617) (Fed. Cir.1985).

Third, Appellant's arguments appear to be based on element that is not part of the claim, unclaimed, or undefined element. "*a pair of person or child eyeglasses*" is not a positive part of the claims and it is improper to define elements of the claimed invention (such as the arms) based on a comparison to "*not part of the claims, unclaimed and undefined elements*". This creates the situation wherein one instance a device would infringe the claimed subject matter because of its use. Also as mentioned in the final office action, the examiner has reviewed the specification and found no specific teachings or criticalities of the sizes of the arms or the sizes of the person's child's eyeglasses so that "*the eyeglass contact each of the arms or appendages*" as

recited in claims 1 and 7. There is no evidence in the specification that teaches the sizes has been set forth when the claim is read in light of the specification. For these reasons, the claims are further rendered indefinite by the recitation that "the arms or appendages together with the body or torso are sized to accommodate a pair of a person's or child's eyeglasses so that the eyeglasses contact each of the arms or appendages". Therefore arguing that "the claims cannot reasonably be interpreted to encompass something as "large as the furniture or table referred to in Aloisi" is unpersuasive.

Fourth, argument that nothing within the four corners of Aloisi even suggests a figure that can be arranged or sized in claims 1 and 7 is also found unpersuasive. The examiner respectfully submits that nothing in Aloisi reference also even suggested a figure that cannot be arranged or sized to accommodate a pair of eyeglasses so that the eyeglass can contact each of the arms or appendages as recited in claims 1 and 7. The teachings in Appellant's specification and Aloisi's specification are both considered as non-limiting.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.
Respectfully submitted,

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